



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,976	10/04/2001	Richard Lawn	32136191.10	5692

23562 7590 12/09/2003

BAKER & MCKENZIE
PATENT DEPARTMENT
2001 ROSS AVENUE
SUITE 2300
DALLAS, TX 75201

EXAMINER

RODRIGUEZ, PAUL L

ART UNIT	PAPER NUMBER
----------	--------------

2125

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/971,976

Applicant(s)

LAWN ET AL.

Examiner

Paul L Rodriguez

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2125

DETAILED ACTION

1. The request for continued examination and amendment have been received and considered. Claims 7-16 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/20/03 has been entered.

Claim Objections

3. Claims 11 and 12 are objected to because of the following informalities:

Claim 11 line 1-2 recites "the color measurements", previously recites "at least one color measurement", would be better as "the at least one color measurement is", could create an antecedent problem in the claim.

Claim 11 line 2 refers to "the selected coloring algorithm", claim 7 recites a server for selecting however one was not previously selected. Could create an antecedent problem in the claim.

Claim 12 line 4 and line 8 recite "particular Application", unsure why "application" is capitalized.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2125

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 12 recites the limitation "the server" in line 5. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: "storing information provided by a coloring algorithm developer regarding" and "said client computer allowing a user to review said information using said server; said user designating color data to said server and said server selecting...based upon said designated color data, the information and the particular application". The claim is unclear as to where the "information" is provided from and it is unclear as to how or why the server makes a selection. Currently, the server provides the "use" and "application" information to a client computer and the server performs a selection of an algorithm only. It is the Examiners position that the limitations recited do not support an exchange or support accessing algorithms.

7. Claims 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "receiving information from developers", "the server

Art Unit: 2125

providing information to a client” and “the server selecting...based on client computer request and the information and the particular application”. The claim is unclear as to where the “receiving information” is provided from, as per the specification it is the developer who provides this information to the algorithm exchange. The claim is unclear as to the limitation of “providing the information”, the “information” provided to the client computer is the same that is previously received, where it was received is also unclear. The claim is unclear as to the elements used in “selecting ... of the coloring algorithms”, is it the database, server or client computer used for the selection process. It is the Examiners position that the claim limitations do not adequately describe selecting an algorithm.

8. Due to the number of 35 USC § 112 second paragraph rejections, the examiner has provided a number of examples of the claim deficiencies in the above rejection(s), however, the list of rejections may not be all inclusive. Applicant should refer to these rejections as examples of deficiencies and should make all the necessary corrections to eliminate the 35 USC § 112 second paragraph problems and place the claims in a proper format.

9. Due to the vagueness and a lack of a clear definition of the terminology and phrases used in the specification and claims, the claims have been treated on their merits as best understood by the examiner.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2125

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 7-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yon et al (U.S. Pat 6,507,824). The claimed invention reads on Yon et al as follows:

Yon et al discloses (claim 7) an algorithm exchange (defined by applicant as linking users to developers and storing information regarding coloring algorithms, figure 1, col. 2 lines 26-38, col. 4 lines 26-41) for providing access to coloring algorithms (coloring algorithms are defined as used to calculate a resulting recipe or to determine a color recommendation, col. 3 lines 24-34, access to a coloring algorithm is considered access to an appropriate database which allows a user to determine or match the target color) said algorithm exchange comprising a database for storing information (reference number 16, 35, 37, col. 2 lines 31-33) regarding the use of one or more of a plurality of coloring algorithms for a particular application (col. 3 lines 14-44, "use of" is considered to be related to the selected product and "particular application" is considered to be related to the example of a plastic vendor offering a variety of plastics), a server (reference numbers 20, col. 2 lines 48-50) associated with the database (figure 1), for providing the information to a client computer (client reference number 18, col. 2 lines 30-38, col. 2 lines 56-67, col. 3 lines 29-39), and for use in selecting at least one of the plurality of coloring algorithms based on the information and the particular application (col. 3 lines 24-34), (claim 8) wherein the database stores the plurality of coloring algorithms (col. 3 lines 29-34, col. 6 line 63 – col. 7 line 12, col. 7 lines 51-62, database stores product, vendor and color data used to make color recommendations), (claim 9) wherein the server further comprises a computer readable medium (col. 8 lines 13-32) for storing a script program (defined by applicant to provide access to

Art Unit: 2125

application programs and display web pages, col. 8 lines 3-21) said script program providing access to the plurality of coloring algorithms (col. 2 lines 39-50, col. 8 lines 3-11), (claim 10) wherein the server is further adapted to receive at least one color measurement from the client computer (col. 3 line 45 – col. 4 line 25) and the database is further adapted for storing the at least one color measurement (col. 6 line 63 – col. 7 line 12, Examiner considers the database as a collection of data storage elements, reference number 35 which is part of the cooperative database stores sample orders, sample orders contain measurement information such as the target color of col. 3 line 45 – col. 4 line 25), (claim 11) wherein the color measurements are used as inputs to the selected coloring algorithms for providing resulting color data to the client computer from the server (col. 3 line 65 – col. 4 line 25), (claim 12) a method for selecting a coloring algorithm (col. 3 lines 14-23), said method comprising receiving information regarding the use of one or more of a plurality of coloring algorithms for a particular application (col. 2 lines 30-33, col. 3 lines 14-34, “use of” is considered to be related to the selected product and “particular application” is considered to be related to the example of a plastic vendor offering a variety of plastics, color database is populated with algorithm information), storing the information in a database associated with the server (col. 2 lines 30-34), providing the information to a client computer (figures 2-5, col. 2 lines 56-67), selecting at least one of the plurality of coloring algorithms based on the information and the particular application (col. 3 lines 24-34), (claim 13) receiving color measurements from the client computer for use as inputs to the selected coloring algorithms for providing resulting color data to the client computer (col. 3 line 45 – col. 5 line 28), (claim 14) storing the color measurements in the database (col. 6 line 63 – col. 7 line 12, Examiner considers the database as a collection of data storage units, reference number 35 which is part of the cooperative database stores sample orders, sample

Art Unit: 2125

orders contain measurement information such as the target color of col. 3 line 45 – col. 4 line 25), (claim 15) storing the plurality of coloring algorithms in the database (col. 3 lines 29-34, col. 7 lines 51-62, database stores product, vendor and color data used to make color recommendations) and (claim 16) providing access to the selected coloring algorithms by the client computer (col. 3 lines 24-34).

Response to Arguments

12. Applicant's arguments filed 11/20/03 have been fully considered but they are not persuasive.

Applicant argues, “Yon does not disclose a database for storing information regarding the use of one or more of a plurality of coloring algorithms for a particular application”. In response to this argument, the Examiner relies upon applicant’s disclosure found in the specification. Regarding the “information”, based upon the specification, the “information” described appears to be general in nature, page 8 lines 15-19 refers to information which can be reviewed by a user to select a particular algorithm, page 11 line 21 – page 12 line 1 refers to information regarding the developers algorithms, page 12 lines 6-9 refers to searchable information regarding the algorithms allowing a user to select the best suited algorithm and page 14 lines 10-18 states that color measurements for use by an algorithm can be catalogued and stored in the database. In regards to “the use of a coloring algorithm for a particular application”, page 3 lines 8-14 describes the recipe prediction algorithm, relying on interactions between colorants and substrates and which algorithms are good or poor for a particular use, an example of metallic paints and textiles is given, page 3 lines 15-23 describe color recommendation algorithms where the use and application are directed toward providing color advise and page 8 lines 6-8 group both the recipe generation and color recommendation algorithms together and refer to them

Art Unit: 2125

collectively as coloring algorithms. Therefore, based on the description found in specification and the Examiners interpretation of the claim language, the examiner contends that Yon et al still reads on applicant's claimed invention. Yon et al discloses a database (16), which stores information (nature of a database, inherent), information is regarding the use of an algorithm (col. 3 lines 14-44, either to browse or search for a colors or related color of a particular product) and the information is regarding a particular application (type of plastic or material is considered a particular application), argument not persuasive.

Applicant argues, "Yon does not disclose a server associated with the database for providing the information to a client computer". Based upon the general nature of "the information", the Examiner contends that Yon et al clearly discloses a server (20, part of 14 the host), associated with a database (16, 35, 37, collectively the database), for providing information to a client computer (col. 3 lines 1-13). Yon et al discloses establishing client server communications for the exchange of information. Figures 2-5 are server to client interface pages that communicate specific information from the host to the client for providing information, information related to the information stored in the databases, therefore the argument is not persuasive.

Finally, applicant argues, Yon does not disclose a server "for use in selecting at least one of the plurality of coloring algorithms". Examiner considers Yon's access by a potential purchaser (client) to the server for selecting a particular product for a color match, wherein each product has unique colors and material associated with it, and the server, based upon the user selection, associates the server with the appropriate database (as described in col. 3 lines 24-34) as meeting this limitation.

Art Unit: 2125

Examiner would like to point out that claim 7 is directed toward access to a coloring algorithm and based upon applicant's description of a coloring algorithm, (one that provides a coloring recommendation) the Yon et al reference is still an applicable reference. Claim 12 is a method of selecting a coloring algorithm, again if the coloring algorithm is related to making a color recommendation, Yon et al allows a user to select a product which then selects an appropriate database and the user selects a search or browse mode of operation, the selection of the coloring algorithm is based on a user selection. During the phone interview of 11/5/03 applicant provided details as to the specific nature of the invention, it was understood by the Examiner that the invention was directed toward a networked exchange arrangement, connecting client computers to a server and database, the database containing coloring algorithms from a plurality of algorithm developers, and the exchange arrangement allows a user, from a client computer, to select from the plurality of coloring algorithms, an algorithm which specifically meets the need or application of the user. Examiner contends that the newly submitted claims have not captured the invention as discussed during the telephone interview and have not overcome the Yon et al reference.

Conclusion

13. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2125

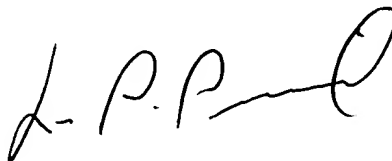
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez
Examiner
Art Unit 2125



PLR
12/03/03

LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100